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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,093	03/16/2001	Stephanie K. Clendennen	4257-0025.30	8290

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EXAMINER

MEHTA, ASHWIN D

ART UNIT

PAPER NUMBER

1638

24

DATE MAILED: 06/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/811,093

Applicant(s)

CLEDENNEN ET AL.

Examiner

Ashwin Mehta

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 08 May 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☒ Newly proposed or amended claim(s) 5 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 5.Claim(s) rejected: 1, 7-15, 19 and 20.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: See Continuation Sheet


Continuation of 3. Applicant's reply has overcome the following rejection(s): the objection to the specification; the rejection of claims 1, 7-19, and 20 under 35 U.S.C. 112, 2nd paragraph; and claim 5 under 35 U.S.C. 112, 1<sup>st</sup> paragraph, written description and scope of enablement.

Continuation of 5. does NOT place the application in condition for allowance because: the amendments to not overcome the rejections of claims 1 and 7-20 under 35 U.S.C. 112, 1st paragraph. Regarding the written description rejection, Applicants argue that it is apparent that nucleotides 156-1708 of SEQ ID NO: 42 correspond to the portion of the sequence shown in Fig. 3A-3C as being the MEL7 promoter (response, page 8, 1<sup>st</sup> full paragraph). As Figs. 3A-C presents the sequence of SEQ ID NO: 42 and distinguishes MEL7 promoter sequences from the other sequences, as argued by Applicants, this aspect of the rejection is overcome. In response to the aspect of the rejection regarding promoter activity of other portions of SEQ ID NO: 42, Applicants argue that Figs. 3A-C contains non-promoter sequences as well as promoter sequences (response, paragraph bridging pages 7-8). However, Fig. 3A-C does not present the sequences of any fragments within nucleotides 156-1708 that retain its promoter activity. Applicants also point out the definition for "promoter" provided in the specification (response, paragraph bridging pages 7-8). However, this only provides a function, without correlating it to a structure. The only structure described by the specification as having fruit-associated transcriptional activity is nucleotides 156-1708 of SEQ ID NO: 42.

In response to the scope of enablement rejection: In response to the aspect of the rejection regarding bases 156-1708 of SEQ ID NO: 42, Applicants again argue that region of the sequence that makes up the MEL7 promoter is shown in Figs. 3A-3C (response, paragraph bridging pages 8-9). As this region corresponds to bases 156-1708 of SEQ ID NO: 42, Applicants' argument is found persuasive and this aspect of the rejection is withdrawn. In response to the aspect of the rejection that fruit-associated promoter activity of other portions of SEQ ID NO: 42 are not enabled, Applicants admit that specific sub-fragments of the MEL7 promoter region that retain fruit-associated promoter activity are not described in the specification, but argue that routine promoter deletion analysis can be used to identify DNA sequences within the MEL7 promoter that can direct fruit-associated expression of a downstream gene (response, paragraph bridging pages 8-9). However, the specification does not provide any guidance as to the sequences within the promoter of bases 156-1708 of SEQ ID NO: 42 that are essential to its tissue-specific activity. Also, see *Genentech, Inc. V. Novo Nordisk, A/S*, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997), which teaches that "the specification, not the knowledge of one skilled in the art" must supply the enabling aspects of the invention.

Continuation of 10. Other: Claim 5 is withdrawn from the rejections under 35 U.S.C. 112, 1<sup>st</sup> paragraph, but is objected as being dependent upon a rejected base claim.

In the Office action mailed 11 December 2002, in the paragraph bridging pages 6-7, the Examiner noted that newly introduced SEQ ID NO: 46 set forth the nucleotide sequence of Genbank Accession No. Z70522, which was revised after the filing of the instant application. As SEQ ID NO: 46 represents a sequence that was determined after the filing date, it should be removed or replaced with the version of the sequence that appeared in Genbank Accession No. Z70522 before the filing date of the instant application.

  
ASHWIN D. MEHTA, PH.D  
PATENT EXAMINER